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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,637	03/21/2001	Anthony Cornelis de Visser	VER-142XX	3042

207 7590 08/29/2002

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BOSTON, MA 02109

EXAMINER

SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 08/29/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-9

Office Action Summary

Application No.

09/744,637

Applicant(s)

DE VISSER ET AL.

Examiner

Betelhem Shewareged

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 13-18, 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's response filed on 08/05/2002 has been fully considered.

Election/Restrictions

2. Applicant's election with traverse of Group I, claims 1-12 and 19 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that examination of all of the claims is not seen as imposing an undue burden on the examiner. This is not found persuasive because the current application contains three distinct inventions in which the examiner is required to search in three search areas. Searching in more than one search area imposes an undue burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Specification

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-12 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claim 1, 11, 12 and 19, it is not clear if the transfer paper comprises a base (not disclose) and the release or barrier layer, or if the transfer paper it self is used as a base layer. It is not clear which layer is to be transferred. It is not clearly disclosed on

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what the release or barrier layer is provided on. It is not clear if the photo quality paper and/or the coated base are different from the transfer paper. Clarification of the structure is kindly requested.

b. Claim 2 recites the limitation "the wire side" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohno et al. (US 6,383,611) in view of Malhotra et al. (US 5,897,961).

Kohno discloses an ink jet recording sheet comprising a coated paper (col. 7, line 40) and an ink receiving layer (equivalent to the claimed release or barrier layer, hereinafter barrier layer) containing a white pigment such as talc or kaolin (col. 4, line 30), a binder such as polyvinyl alcohol, gelatin, carboxymethyl cellulose (col. 6, line 57), and a dye (col. 8, line 31). With respect to porosity value, and transferability and ink absorbing properties it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Kohno reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function

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in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Kohno does not disclose the ink receiving layer is being applied on to a certain side, i.e., wire side of the paper base. It is known that the wire side of a paper is smoother, and it is also known that applying a coating composition onto a smoother surface improves surface contact between the paper and the coated layer. Therefore, at the time of the invention, a person of ordinary skill in the art would have been motivated to select the smoother side of a paper in order to increase surface contact.

Kohno fails to disclose the claimed amount of filler (up to 15%). The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust the content of filler in order to optimize the ink-absorbing properties of the layer. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

Kohno does not disclose a photographic base paper.

Malhotra teaches coated ink jet paper comprising an ink receiving layer coated on a photographic paper (col. 8, line 54), wherein the ink receiving layer comprises binder (col. 8, line 61) and filler (col.9, line 59).

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Kohno and Malhotra are analogous art because they are from the same field of endeavor that is the ink jet recording sheet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the photographic base paper of Malhotra with the invention of Kohno in order to provide a recording medium, which exhibits image with high gloss, high optical density, and improved waterfastness and lightfastness (col. 7, line 5 of Malhotra).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

BS *BS*
August 21, 2002.